

REMARKS

The Office Action of February 17, 2009 was received and carefully reviewed. Reconsideration and withdrawal of the currently pending rejections are requested for the reasons advanced in detail below.

Claims 1 and 19-37 were pending prior to the instant amendment, with claims 25 and 35 being withdrawn from consideration. By this amendment, claims 1 and 26 are amended. Consequently, claims 1 and 19-24, 26-34, 36 and 37 are pending for consideration in the instant application with claims 1 and 26 being independent.

In the Office Action, claims 1, 19-24 and 36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,639,265 to Arao et al., embodiment 1, FIGS. 1-7 and 11 (Arao), in view of Arao, embodiment 9, FIGS. 8A-B and 9, and further in view of U.S. Pat. Pub. 2002/0006558 to Kobayashi et al. (Kobayashi) and claims 26-34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Arao, embodiment 1, in view of Arao, embodiment 9, and Arao, embodiment 11, FIGS. 29A-29B and further in view of Kobayashi. These rejections are traversed for at least the reasons addressed below.

Arao taken as a whole and Kobayashi, however, fail to render the claimed invention unpatentable. Each of the claims recite a specific combination of features that distinguishes the invention from the prior art in different ways. For example, independent claim 1, as amended, recites a combination that includes, among other things:

an interlayer insulating film formed over the thin film transistor ...
wherein the interlayer insulating film is interposed between the base film
and the pixel electrode ... wherein each of the plurality of conductors is in
direct contact with the interlayer insulating film.

(See, for example, FIG. 1D and page 23, lines 10-11 of specification). And independent

claim 26, as amended, recites yet another combination that includes, *inter alia*,

an interlayer insulating film formed over the thin film transistor ... a first insulating film formed over the first wiring; a second wiring formed over the first insulating film ... a second insulating film formed over the second wiring ... wherein the interlayer insulating film is interposed between the base film and the pixel electrode ... wherein each of the plurality of first conductors is in direct contact with the interlayer insulating film and each of the plurality of second conductors is in direct contact with the second insulating film.

(See, for example, FIG. 1D and page 23, lines 10-11 of specification). At the very least, the applied references, whether taken alone or in combination, fail to disclose or suggest any of these exemplary features recited in independent claims 1 and 26.

The Examiner has failed to establish a *prima facie* case of obviousness for at least four reasons. First, the Examiner has not demonstrated how Arao taken as a whole and Kobayashi, whether taken alone or in combination, disclose or suggest each and every feature recited in the claims. *See* M.P.E.P. § 2143 (7th ed. 1998). Second, the Examiner has not shown the existence of any reasonable probability of success in modifying Arao, the base reference, based on the teachings of various embodiments of Arao and Kobayashi, the secondary references, in a manner that could somehow result in the claimed invention. *See id.* Third, the Examiner has not identified any suggestion or motivation, either in the teachings of the applied references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the apparatus of Arao in a manner that could somehow result in the claimed invention. *See id.* Finally, the Examiner has not explained how his obviousness rationale could be found in the prior art — rather than being a hindsight reconstruction of Applicants' own disclosure. *See id.*

Each of the Examiner's factual conclusions must be supported by "substantial

evidence" in the documentary record, as required by the Federal Circuit. *See In re Lee*, 61 U.S.P.Q.2d 1430, 1435 (Fed. Cir. 2002). The Examiner has the burden of documenting all findings of fact necessary to support a conclusion of anticipation or obviousness "less the 'haze of so-called expertise' acquire insulation from accountability." *Id.* To satisfy this burden, the Examiner must specifically identify where support is found within the prior art to meet the requirements of 35 U.S.C. §§ 102(b) and 103. In this case, however, the Examiner has failed to satisfy his burden of demonstrating how Arao taken as a whole, alone or in combination with Kobayashi, can either anticipate or render obvious each and every one of the limitations present in independent claims 1 and 26, as required by the M.P.E.P. and Federal Circuit jurisprudence.

Although Applicants do not accept the Examiner's statement (an insulating film in claims 1 and 26 corresponds to an insulating film [141+150+151] in FIG. 11 of Arao), in order to move prosecution forward of the present application, Applicants have amended independent claims 1 and 26 to add the technical features as mentioned above of "an interlayer insulating film," "wherein the interlayer insulating film is interposed between the base film and the pixel electrode," and "wherein each of the plurality of conductors is in direct contact with the interlayer insulating film," which are supported, for example, in the Original Specification at FIG. 1D and on page 23 at lines 10-11.

Applicants contend that the feature of the interlayer insulating film as presently recited in claims 1 and 26 does not correspond to the film [141+150+151] in Arao since Applicants believe that the feature of an interlayer insulating film of the present invention would only correspond to interlayer insulating film 141 in Arao. Further, Applicants believe that the Examiner can more clearly understand the foregoing Remarks in the response filed November 24, 2008 in light of the above amendments. Especially, Applicants contend that

the interlayer insulating film 141 is only in direct contact with a Ti film 1256a as shown in Arao (see, for example, FIG. 22A-B and embodiment 7 of Arao).

The Examiner attempts to remedy the deficiencies of Arao by turning to Kobayashi. Kobayashi discusses the use of a photocatalyst. However, Kobayashi fails to disclose or suggest the features of an interlayer insulating film, wherein the interlayer insulating film is interposed between the base film and the pixel electrode and wherein each of the plurality of conductors is in direct contact with the interlayer insulating film, as recited in claims 1 and 26.

Therefore, Applicants believe that the claimed invention cannot be obtained even if the references are combined with each other and that the amended claims should be allowable.

In accordance with the M.P.E.P. § 2143.03, to establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 196 (CCPA 1970). Therefore, it is respectfully submitted that neither Arao nor Kobayashi, taken alone or in any proper combination, discloses or suggests the subject matter as recited in claims 1 and 26. Hence, withdrawal of the rejection is respectfully requested.

Each of the dependent claims depend from one of independent claims 1 or 26 and are patentable over the cited prior art for at least the same reasons as set forth above with respect to claims 1 and 26.

In addition, each of the dependent claims also recite combinations that are separately patentable.

In view of the foregoing remarks, this claimed invention, as amended, is not rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this response, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

In discussing the specification, claims, and drawings in this response, it is to be understood that Applicants in no way intend to limit the scope of the claims to any exemplary embodiments described in the specification and/or shown in the drawings. Rather, Applicants are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

Should the Examiner believe that a telephone conference would expedite issuance of the application, the Examiner is respectfully invited to telephone the undersigned agent at (202) 585-8100.

Respectfully submitted,

/Sean A. Pryor, Reg.#48103/
Sean A. Pryor
Registration No. 48,103

NIXON PEABODY LLP
CUSTOMER NO.: 22204
Suite 900, 401 9th Street, N.W.
Washington, D.C. 20004-2128
(202) 585-8000